

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Robert E. Haines et al.	<b><u>CERTIFICATE OF FACSIMILE TRANSMISSION</u></b> I hereby certify that this paper is being facsimile transmitted to the <b>United States Patent and Trademark Office, Alexandria, Virginia</b> on the date below.
Title: HARDCOPY OUTPUT ENGINE CONFIGURATION APPARATUS AND METHOD	
Appl. No.: 09/976,626	(Printed Name)
Filing Date: 02/17/2004	(Signature)
Examiner: Meucci, Michael D.	(Date of Deposit)
Art Unit: 2142	

**BRIEF ON APPEAL**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**1. Real Party in Interest**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, California. The general or managing partner of HPDC is HPQ Holdings, LLC.

## **2. Related Appeals and Interferences**

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellants or Appellants' patent representative.

## **3. Status of Claims**

Claims 1-8, 10-16, 18-23 and 25-35 are pending. This is an appeal from the Office Action mailed on March 25, 2009 rejecting claims 1-8, 10-16, 18-23 and 25-35.

## **4. Status of Amendments**

No amendments were filed after the Office Action mailed on March 25, 2009.

## **5. Summary of Claimed Subject Matter**

### **A. Claim 1**

Claim 1 recites a method of configuring a hard copy output engine, the method comprising:

receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall, wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured (Page 10, lines 17-20); and

configuring the hard copy output engine using the hard copy output engine configuration data. (Page 2, lines 15-18; Page 10, lines 17-20)

### **B. Claim 2**

Claim 2 depends from claim 1 and further recites that receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data. (Page 10, lines 17-20).

C. Claim 3

Claim 3 depends from claim 1 and further recites that receiving the electronic message comprises receiving an email. (Page 10, lines 17-20).

D. Claim 4

Claim 4 depends from claim 1 and further recites that receiving the electronic message comprises:

receiving an email through the firewall at a first user station (Page 10, lines 17-20); and

forwarding the email to the hard copy output engine. (Page 10, lines 17-22).

E. Claim 5

Claim 5 depends from claim 1 and further recites that receiving the electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed. (Page 9, lines 28-Page 10, line 3; Page 10, lines 6-8; Page 10, lines 27-31; Page 14, lines 16-19).

F. Claim 8

Claim 8 recites an apparatus comprising:

a device (14) configured to provide a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Page 10, lines 17-20); and

configure the hard copy output engine using the configuration data, wherein the computer instruction signal embodied in the carrier wave carrying

instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email at the hard copy output engine, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure comprises a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Page 10, lines 17-20).

G. Claim 14

Claim 14 recites a computer implemented control system for a hard copy output engine, the system comprising:

memory (24) configured to store a software module (page 6, lines 12-15); and

processing circuitry (20) configured to employ the software module (page 6, lines 12-15) to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Page 10, lines 17-22); and

configure the hard copy output engine using the configuration data (Page 10, lines 17-22), wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to:

receive an email through the firewall at a first user station (Page 10, lines 17-20); and

forward the email to the hard copy output engine. (Page 10, lines 17-22)

H. Claim 20

Claim 20 depends from claim 14 and further recites that the processing circuitry configured to employ the software module to configure the hard copy output

engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via the embedded web server (Page 10, lines 17-20) to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (page 9, lines 28-page 10, line 3; Page 10, lines 27-31; Page 9, lines 28-33; Page 14, lines 16-19).

I. Claim 21

Claim 21 recites an article of manufacture comprising a computer usable medium having computer readable code embodied therein that is configured to cause a processor to:

receive an electronic message including hard copy output engine configuration data from a website through a firewall (Page 10, lines 17-20); and  
configure the hard copy output engine using the configuration data, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to:

receive an email through the firewall at a first user station (Page 10, lines 17-20); and

forward the email to the hard copy output engine. (Page 10, lines 17-22).

J. Claim 22

Claim 22 depends from claim 21 and further recites that the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email at the hard copy output engine, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data. (Page 10, lines 17-20)

K. Claim 26

Claim 26 depends from claim 21 and further recites that the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an XML script (Page 10, lines 6-8), and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers. (Page 3, lines 30-32).

L. Claim 27

Claim 27 recites a method comprising:

forming hard copy output engine configuration data on a first side of a firewall based upon input received from a second side of the firewall (Page 7, lines 24-28; Page 9, lines 28-page 10, line 3); and

transmitting an electronic message including the configuration data through the firewall to a hard copy output engine on the second side of the firewall. (Page 10, lines 4-6 and 17-20).

M. Claim 28

Claim 28 depends from claim 27 and further recites that the electronic message comprises an email. (Page 10, lines 17-20).

N. Claim 29

Claim 29 depends from claim 27 and further recites that transmitting the electronic message comprises:

transmitting the electronic message to a user station (Page 10, lines 17-20); and

forwarding the electronic message to the hard copy output engine. (Page 10, lines 17-22).

O. Claim 32

Claim 32 depends from claim 27 and further recites that the hard copy output engine configuration data designates a website on the first side of the firewall as a contact for the hard copy output engine, wherein the website was not previously designated to the hard copy output engine. (Page 9, lines 17-19; Page 10, lines and 8-11; Page 10, lines 14-16).

P. Claim 33

Claim 33 depends from claim 27 and further recites providing the input from the second side of the firewall to the first side of the firewall. (Page 7, lines 24-28; Page 9, lines 28-page 10, line 3).

Q. Claim 34

Claim 34 depends from claim 33 and further recites that the step of providing the input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall. (Page 7, lines 24-28; Page 9, lines 28-Page 10, line 3).

R. Claim 35

Claim 35 depends from claim 27 and further recites receiving the electronic message with a web server embedded in the hard copy output engine. (Page 10, lines 17-20).

**6. Grounds of Rejection to be Reviewed on Appeal**

The issues on appeal are **(1)** whether the Examiner erred in rejecting claims 27-35 under 35 U.S.C. §101; **(2)** whether the Examiner erred in rejecting claims 1, 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon); and **(3)** whether the Examiner erred in rejecting claims 2-5, 8, 10-16, 18-23 and 25-35 under 35 U.S.C. §

103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon) and further in view of US Patent 7,126,716 (Kaufman).

## **7. Argument**

Prior to presenting actual arguments, Appellants wish to respectfully voice concern over the prosecution of the present case. This appeal is the second appeal filed in the case in response to a seventh office action. As amendments to the claims during prosecution have been largely deminimus, Appellants do not understand why a comprehensive search was not performed at least after the third or fourth office action. The resulting piecemeal prosecution does not appear to meet the often stated objective of a compact prosecution.

### **I. Legal Standards**

#### **A. Law Regarding Patentable Subject Matter Under 35 U.S.C. § 101**

Claims 27-35 are rejected under 35 U.S.C. § 101 which states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Under 35 U.S.C. § 101, three categories of inventions are excluded from patentability: laws of nature, natural phenomena and abstract ideas. See Diamond v. Diehr, 450 U.S. 175 (1981). A method of doing business is not to be viewed as abstract per se, but depends on whether it produces a useful, concrete and tangible result. State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998). A method or process claim satisfies the "useful, concrete and tangible" test when it is shown that the method or process is tied to a particular machine or transforms an article. In re Bilski, 545 F.3d 943 (Fed. Cir. 2008). A method or process is tied to a particular machine when the particular machine or transformation of an article imposes meaningful limits on claim scope and is not merely insignificant



extra-solution activity. Id. A method or process transforms an article when an article is transformed to a different state or thing by a machine or where data transformed without the use of a machine is representative of physical objects or substances. Id.

B. Law of Obviousness

Claims 1-8, 10-16, 18-23 and 25-35 are rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262

F.3d 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)). Teaching away from the claimed invention is a strong indication of non-obviousness and an improper combination of references. U.S. v. Adams, 383 U.S. 39 (1966).

**II. The Examiner's Rejection of Claims 27-35 under 35 USC 101 Should be Reversed Because claims 27-35 are directed to a method that results in the transformation of an article (data) using a machine**

The Examiner rejected claims 27-35 under 35 USC 101 as allegedly not falling within a statutory category of invention. In support of the rejection, the Examiner alleges that:

the steps disclosed in claims 27-35 are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. Additionally, the steps disclosed in claims 27-35 may be implemented in software alone and are therefore not tied to a particular machine.

Appellants respectfully request that the rejection be reversed. Claims 27-35 are indeed directed to patentable subject matter. Claim 27 recites a method which includes: (1) "forming hard copy output engine configuration data on a first side of the firewall based upon input received from a second side of the firewall" and (2) "transmitting an electronic message including the configuration data through the firewall to the hard copy output engine on the second side of the firewall."

A method or process claim satisfies the "useful, concrete and tangible" test when it is shown that the method or process is tied to a particular machine or transforms an article. In re Bilski, 545 F.3d 943 (Fed. Cir. 2008).

In claim 27, there is a transformation of underlying subject matter. In particular, hard copy output engine configuration data is created or formed on a first side of the firewall using data on a second side of the firewall. This transformed data is further transformed by being transmitted as an electronic message through a firewall to a hard copy output engine on a second side of the firewall.

Moreover, in contrast to the assertion made by the Examiner, the steps disclosed in claim 27 could **not** be performed mentally, verbally or without a machine. In particular, claim 27 recites transmitting an electronic message including the configuration data through a firewall. Clearly, one cannot mentally transmit an

electronic message including configuration data through a firewall. Clearly, one cannot verbally transmit an electronic message including configuration data through a firewall. Clearly, to transmit an electronic message including configuration data through a firewall would require some sort of electronic machine capable of doing such.

Furthermore, claim 30, which depends from claim 27, additionally recites “configuring the hard copy output engine using the configuration data” that was transmitted “to the hard copy output engine”. Clearly, configuring a hard copy output engine using the configuration data that was transmitted to the hardcopy output engine would, at minimum, require use of a machine, the hard copy output engine itself. Accordingly, the rejection is improper. Accordingly, the rejection should be reversed.

**III. The Examiner’s Rejection of Claims 1, 6 and 7 under 35 USC 103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon) Should be Reversed Because It Would Not Be Obvious to Modify Gecht based upon Leon so As to Include Every Limitation of Each of the Claims.**

**A. Claim 1**

Claim 1 recites a method of configuring a hard copy output engine. The method includes receiving an electronic message including hard copy output engine configuration data from an undesignated web site through a firewall and configuring the hard copy output engine using the configuration data. The data transmitted through the firewall designates a hard copy output engine to be configured. As set forth in the specification, a “firewall” is a security measure that filters out potentially harmful network data exchanges. (See Specification, page 5, lines 29-33)

Neither Gecht nor Leon, alone or in combination, disclose a method which includes receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall and configuring the hard copy output engine using the configuration data. In contrast, Gecht merely

discloses a system and method for providing remote printing services over a network. Gecht says nothing about configuring a hard copy output engine using configuration data sent as part of an electronic message through a firewall. Rather, as shown in Figures 1 and 10 of Gecht below, Gecht merely discloses the transmission of a print job through a firewall 30 to a spooling server 50 and further transmission of the print job from the spooling server 50 through firewall 70 to printer polling device 100. Gecht also discloses the transmission of the polling request through firewall 70 to the spooling server 50. As clearly understood by those of ordinary skill in the art, a "print job" or a "polling request" is not "configuration data".

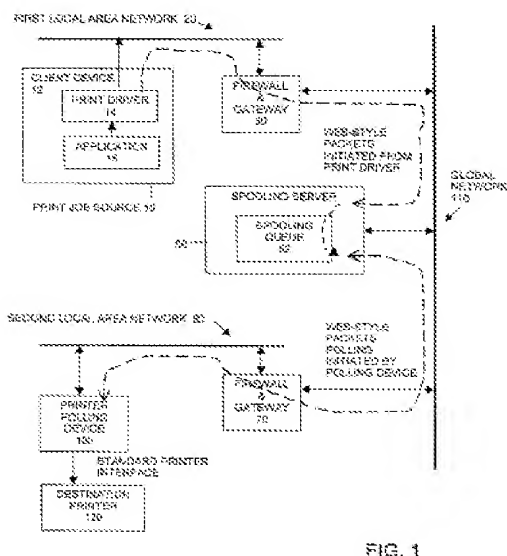


FIG. 1

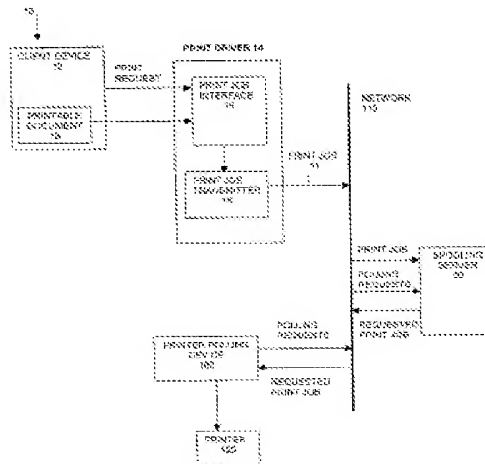


FIG. 10

In rejecting claim 1, the Examiner further incorrectly asserts that Gecht discloses receiving an electronic message including hard copy output and configuration data and configuring the hard copy output engine using hardcopy output engine configuration data by referring to Column 11, line 61 – Column 12, line 16 of Gecht, provided below:

DHCP is a protocol which allows nodes to be added to a TCP/IP network dynamically without specific prior configuration of that node in the domain controller's hosts database. Each node desiring to connect announces itself to the DHCP server. The name of the node is sent to the DHCP server. The DHCP server then

assigns the node a dynamic IP address as well as communicating the IP addresses of other key network services such as name servers, mail hosts, and gateways that are available. Once setup and enabled, this mechanism allows nodes to be added to the network without the intervention of a network administrator.

Ease of installation and configuration is therefore achieved through the use of DHCP by the fact that most local networks are configured to allow network devices to be added without the intervention of an administrator using DHCP. In addition, most local networks allow web access through their firewall (e.g., gateway firewalls 30 and 70). These two factors allow both the print job source 10 and the printer polling device 100 to connect and communicate to the spooling server 50 without the intervention of a network administrator. The user simply plugs in the printer polling device 100 and it accesses the network and starts polling the spooling server 50.

(Emphasis added).

The rejection of claim 1 based in part upon Gecht seems to be relying upon the fact that Gecht happens to disclose that installation and "configuration" is achieved through the use of DHCP. However, the "configuration" that is being discussed by Gecht is NOT the configuration of a hardcopy output engine or printer, but is the configuration of a network. Gecht does not disclose receiving an electronic message including hardcopy output engine configuration data and configuring hardcopy output engine using hardcopy output engine configuration data. Leon fails to satisfy these deficiencies of Gecht. Accordingly, the rejection of play 1 should be reversed. Claims 6 and 7 depend from claim 1 and overcome the rejection for at least the same reasons.

B. Claim 7

Claim 7 depends from claim 1 and further recites that the configuration data include data prepared by:

- determining a make and model for the hard copy output engine;
- determining a serial number for the hard copy output engine; and

determining user thresholds for consumables associated with the hard copy output engine.

Neither Gecht nor Leon disclose receiving an electronic message including hardcopy output engine configuration data which itself includes data prepared by determining a make and model for the hard copy output engine; determining a serial number for the hard copy output engine; and determining user thresholds for consumables associated with the hard copy output engine. In contrast, as noted above, Gecht merely discloses the transmission of a print job to a spooling server and the transmission of the print job from the spooling server to the printer polling device 100. Nowhere does Gecht ever disclose that the print job being transmitted includes data prepared based upon a make and model of printer 120, based on a serial number for printer 120 AND based upon user thresholds for consumables associated with printer 120. In fact, this would seem highly unlikely since, when the print job is created at client device 12, the particular printer which will print the print job is not yet known. Accordingly, the rejection of claim 7 is improper and should be reversed.

**IV. The Examiner's Rejection of 2-5, 8, 10-16, 18-23 and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon) and further in view of US Patent 7,126,716 (Kaufman) Should be Reversed Because It Would Not Be Obvious to Modify Gecht based upon Leon and Kaufman so As to Include Every Limitation of Each of the Claims.**

Claims 2-5 depend from claim 1 and overcome the rejection for the same reasons discussed above with respect to the rejection of claim 1. Similar to claim 1, independent claims 8, 14 and 21 recite receiving an electronic message including hardcopy output engine configuration data through a firewall and configuring hardcopy output engine using the configuration data. Accordingly, each of independent claims 8, 14 and 21 overcome the rejection for the same reasons discussed above with respect to the rejection of claim 1 based upon Gecht and Leon.

Claim 27 recites a method wherein hardcopy output engine configuration data is formed on the first side of a firewall and is transmitted as part of electronic message through the firewall to the hardcopy output engine on the second side of the firewall. Accordingly, claim 27 overcomes the rejection for the same reasons discussed above with respect to the rejection of claim 1 based on Gecht and Leon. Kaufman fails to satisfy the deficiencies of Gecht and Leon.

Claims 2-5, 8, 10-16, 18-23 and 25-35 recite additional limitations which further distinguish such claims over Gecht, Leon and Kaufman. Claims 2-5, 8, 10-16, 18-23 and 25-35 overcome the rejection for the following additional reasons.

A. Claims 2, 8, 15, 20 and 22

Claim 2 depends from claim 1 and recites that receiving the electronic message comprises receiving an email at the hard copy output engine and that configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data. As defined in the Specification, the term "web server" refers to a specialized program running on a server that supports TCP/IP protocol. (See page 7, lines 15-16).

Claim 8 recites an apparatus which includes a device configured to provide a computer instruction signal that when executed by a processor causes a processor to receive an electronic message, comprising an e-mail, including hard copy output engine configuration data from an undesignated website through a firewall and to further configure the hard copy output engine using the configuration data with an embedded Web server contained in the hard copy output engine.

Claim 15 depends from claim 14 and recites that the processing circuitry employs a software module to configure the hard copy output engine with an embedded web server contained in the hard copy output engine.

Claim 22 depends from claim 21 and recites that the computer readable code is configured to cause a processor to configure the hardcopy output engine via an



embedded web server contained in the hard copy output engine using the configuration data.

Claim 20 depends from claim 14 and recites that the processing circuitry is configured to employ the software module to configure the hard copy output engine via an embedded web server contained in the hardcopy output engine and to set threshold for elements chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed.

Neither Gecht, Leon nor Kaufman, alone or in combination, discloses receiving an e-mail including hard copy output engine configuration data. Neither Gecht, Leon nor Kaufman, alone or in combination, disclose a hard copy output engine including an embedded web server that configures the hard copy output engine using the configuration data. In rejecting such claims, the Examiner attempts to (1) rely upon Kaufman for satisfying the limitation "receiving an e-mail including the hardcopy output engine configuration data at the hardcopy output engine" and further attempts to (2) rely upon Leon for satisfying the limitation that the hardcopy output engine includes an embedded web server which receives the e-mail and which configures the hardcopy output engine using the configuration data in the e-mail. The Examiner's reliance upon each of Kaufman and Leon is misplaced.

1. Kaufman fails to disclose receiving an e-mail including hardcopy output engine configuration data.

In rejecting such claims, the Examiner refers to column 6, lines 29-33 of Kaufman (provided below) for its assertion that Kaufman discloses receiving an e-mail including hardcopy output engine configuration data.

As discussed above, preferably the printer 10 is configured such that the printer 10 can **interface** with a device at a remote location via **e-mail** or TCP/UDP over an Intranet, the Internet or over a wireless communication network. This will now be described in more detail.

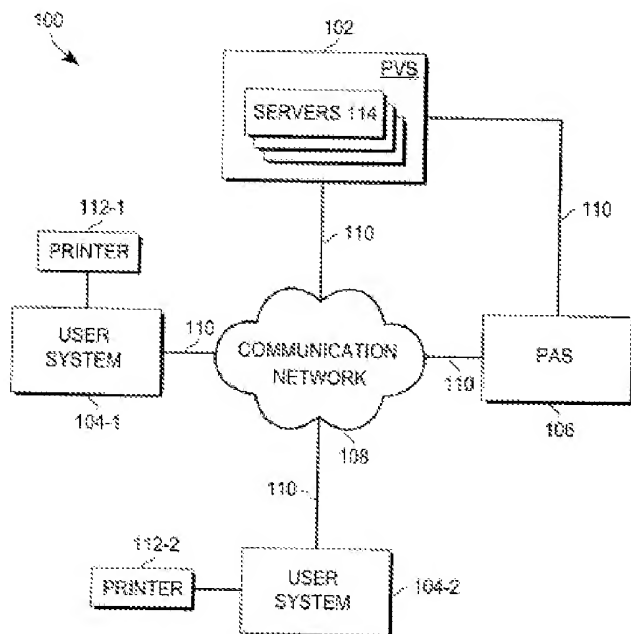
(Kaufman, Column 6, lines 29-33) (Emphasis added).

It appears that the rejection is relying on the fact that Kaufman discloses that printer 10 may "interface" with a device at a remote location via e-mail. However, closer inspection reveals that the "interfacing" referred to by Kaufman is only the sending of e-mails by the printer, NOT the reception of e-mails by the printer. Nowhere does Kaufman disclose "receiving" an e-mail including hardcopy output engine configuration data. At most, Kaufman merely discloses that alerts may be sent to remote locations from the printer using an e-mail which neither teaches nor suggests receiving an e-mail including hardcopy output engine configuration data.

2. Leon fails to disclose an embedded Web server in a hardcopy output engine that configures the hardcopy output engine using the received hardcopy output engine configuration data.

In rejecting such claims, the Examiner points to servers 114 of Leon as constituting the claimed embedded Web servers.

However, as shown in Figure 1 of Leon below, servers 114 are not part of the hardcopy output engine or printer.



Rather, servers 114 are simply part of a bank of servers 114 provided as part of postage vendor system (PVS) 102. Nowhere does Leon even remotely disclose

that servers 114 configure postage vendor system 102 using configuration data received with an e-mail. Accordingly, the rejection of claims 2, 8, 15, 20 and 22 should be reversed for at least these additional reasons. Claims 10-13 depend from claim 8 and overcome the rejection for the same reasons.

B. Claim 3

Claim 3 depends from claim 1 and recites that receiving the electronic message comprises receiving an e-mail.

As noted above with respect to the rejection of claim 2, neither Gecht, Leon nor Kaufman, alone or in combination, discloses receiving an e-mail which includes hard copy output engine configuration data. Accordingly, the rejection of claim 3 should be reversed for this additional reason.

C. Claims 4, 11, 14 and 21

Claim 4 depend from claim 1 and recites that receiving the electronic message comprises receiving an e-mail at a first user station and forwarding e-mail to the hard copy output engine.

Claim 11 depends from claim 8 and recites that the instructions cause a processor to receive an e-mail to the firewall a first user station and to forward e-mail to the hard copy output engine.

Claim 14 recites a computer implemented control system for a hard copy output engine. The system includes processing circuitry configured to employ the software module of memory to receive an electronic message including hard copy output engine configuration from an undesignated website through a firewall and to configure the hard copy output engine using the configuration data. The processing circuitry is further configured to receive an e-mail through the firewall in a first user station and before the e-mail to the hard copy output engine.

Claim 21 recites an article of manufacture comprising a computer usable medium having computer readable code embodied therein is configured to cause a

processor to (1) to receive an electronic message including hard copy output engine configuration data from a website through a firewall and (2) to configure the hard copy output engine using the configuration data. The code is further configured to cause a processor to receive an e-mail to the firewall a first user station in the fourth e-mail to the hard copy output engine.

As noted above, neither Gecht, Leon nor Kaufman, alone or in combination, discloses receiving an e-mail including hardcopy output engine configuration data, let alone, forwarding such an e-mail to a hard copy output engine. Thus, the rejection of claims 4, 14 and 21 should be reversed for this additional reason. The rejection of claims 15-16 and 18-20, which depend from claim 14, should also be reversed. The rejection of claims 22-23 and 25-26, which depend from claim 21, should be reversed for at least the same reasons.

D. Claims 5 and 26

Claim 5 recites that receiving an electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed.

Claim 26 depends from claim 21 and recites that the computer readable code is configured to cause a processor to receive the electronic message comprising an XML script including the hardcopy output engine configuration data.

Neither Gecht, Kaufman nor Leon, alone or in combination, disclose receiving an electronic message comprising XML script including hard copy output engine configuration data. In rejecting such claims, the Examiner attempts to rely upon Kaufman by pointing to column 7, lines 14-19 of Kaufman provided below.

Preferably, as shown in FIG. 4, the printer 10 is configured such that a user 180 can upload the printer's settings in a **format** such as XML, can view and modify the settings using a web browser, and can thereafter **download the settings** back to the printer 10, or to other

printers (10a, 10b, 10c, etc.) in the network to facilitate cloning.

(Kaufman, column 7, lines 14-19) (Emphasis added).

However, the Examiner's reliance upon Kaufman is misplaced. Kaufman does NOT disclose receiving a XML **script**. In contrast, Kaufman merely discloses that the printer settings are transmitted in the XML **format**. An XML format is not the same as an XML script. As known to those of ordinary skill in the art, an XML format is simply the format of the data, whereas an XML script is a script or program (similar to JAVA SCRIPT). Sending data in a particular format is not the same as sending a script or program. Accordingly, the rejection of claims 5 and 26 should be reversed for this additional reason.

E. Claims 27-35

The Examiner rejected claims 27-35 based upon Gecht, Leon and Kaufman by simply asserting that:

Claims 27-35 are method-equivalents of the apparatus claims 8 and 10-13 and a rejected under the same rationale.

(Office Action dated March 25, 2009, p. 13).

However, this is not true. Claim 27 and 35 contain distinct and different limitations. For example, claim 27 recites "forming hardcopy output engine configuration on a first side of a firewall based upon input received from a second side of the firewall." (Emphasis added). Claim 32 recites that the hardcopy output engine configuration data "designate a website on the first side of the firewall as a contact for the hardcopy output engine, wherein the website was not previously designated to the hardcopy output engine." Claim 34 recites that step for providing input comprises "interacting with a website on the first side of firewall with a web browser on the second side of the firewall."

Neither Gecht, Leon nor Kaufman, alone or in combination, disclose such limitations. The Examiner has failed to articulate where Gecht, Leon or Kaufman

allegedly disclose such limitations. The Examiner has failed to establish a prima facie case of obviousness with respect to each of claims 27-35. Moreover, none of these limitations is found in claims 8 or claims 10-13. Accordingly, the rejection of claims 27-35 should be reversed

### **Conclusion**

In view of the foregoing, the Appellants submit that **(1)** claims 27-35 are not properly rejected under 35 USC 101 and are therefore patentable; **(2)** claims 1, 6 and 7 are not properly ejected under 35 USC 103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon) and are therefore patentable; and **(3)** claims 2-5, 8, 10-16, 18-23 and 25-35 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,859,832 (Gecht) in view of US Patent Publication 2001/0042052 (Leon) and further in view of US Patent 7,126,716 (Kaufman) and are therefore patentable. Accordingly, Appellants respectfully request that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

**Summary**

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 24th day of August, 2009.

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**CLAIMS APPENDIX**

1. (Previously Presented) A method of configuring a hard copy output engine comprising:
  - receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall, wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured; and
  - configuring the hard copy output engine using the hard copy output engine configuration data.
2. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data.
3. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises receiving an email.
4. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises:
  - receiving an email through the firewall at a first user station; and
  - forwarding the email to the hard copy output engine.
5. (Original) The method of claim 1, wherein receiving the electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.



6. (Original) The method of claim 1, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers.
7. (Original) The method of claim 1, wherein the configuration data include data prepared by:
  - determining a make and model for the hard copy output engine;
  - determining a serial number for the hard copy output engine; and
  - determining user thresholds for consumables associated with the hard copy output engine.
8. (Previously Presented) An apparatus comprising:
  - a device configured to provide a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to:
    - receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall;
    - and
    - configure the hard copy output engine using the configuration data,
  - wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email at the hard copy output engine, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure comprises a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data.
10. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions

that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email through the firewall.

11. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to:

receive an email through the firewall at a first user station; and  
forward the email to the hard copy output engine.

12. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to cause the processor to configure the hard copy output engine includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

13. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an XML script, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers.

14. (Previously Presented) A computer implemented control system for a hard copy output engine, the system comprising:

memory configured to store a software module; and

processing circuitry configured to employ the software module to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall; and

configure the hard copy output engine using the configuration data, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to:

receive an email through the firewall at a first user station; and forward the email to the hard copy output engine.

15. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to employ the software module to receive an email at the hard copy output engine, and wherein the processing circuitry configured to employ the software module to configure the hard copy output engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via an embedded web server contained in the hard copy output engine.

16. (Previously Presented) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to employ the software module to receive an email through the firewall.

18. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to receive an electronic message

comprises processing circuitry configured to employ the software module to receive an XML script.

19. (Original) The computer implemented control system of claim 14, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers.

20. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to configure the hard copy output engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

21. (Previously Presented) An article of manufacture comprising a computer usable medium having computer readable code embodied therein that is configured to cause a processor to:

- receive an electronic message including hard copy output engine configuration data from a website through a firewall; and
- configure the hard copy output engine using the configuration data, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to:
  - receive an email through the firewall at a first user station; and
  - forward the email to the hard copy output engine.

22. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email at the hard copy output engine, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the

processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data.

23. (Previously Presented) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email through the firewall.

25. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, number of hours of operation and number of sheets of print media consumed.

26. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an XML script, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers.

27. (Previously Presented) A method comprising:  
forming hard copy output engine configuration data on a first side of a firewall based upon input received from a second side of the firewall;  
and  
transmitting an electronic message including the configuration data through the firewall to a hard copy output engine on the second side of the firewall.

28. (Previously Presented) The method of claim 27, wherein the electronic message comprises an email.

29. (Previously Presented) The method of claim 27, wherein transmitting the electronic message comprises:

transmitting the electronic message to a user station; and  
forwarding the electronic message to the hard copy output engine.

30. (Previously Presented) The method of claim 27 further comprising configuring the hard copy output engine using the configuration data.

31. (Previously Presented) The method of claim 27 further comprising transmitting an electronic message including an address of the hard copy output engine from the second side of the firewall to the first side of the firewall.

32. (Previously Presented) The method of claim 27, wherein the hard copy output engine configuration data designates a website on the first side of the firewall as a contact for the hard copy output engine, wherein the website was not previously designated to the hard copy output engine.

33. (Previously Presented) The method of claim 27 further comprising providing the input from the second side of the firewall to the first side of the firewall.

34. (Previously Presented) The method of claim 33, wherein the step of providing the input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall.

35. (Previously Presented) The method of claim 27 further comprising receiving the electronic message with a web server embedded in the hard copy output engine.

## EVIDENCE APPENDIX

There is no evidence previously submitted under 37 C.F.R. §§ 1.130, 1.131 or 1.132 or other evidence entered by the Examiner and relied upon by Appellant in this appeal. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(ix) are satisfied.

## RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a Court of the Board in a proceeding identified in the Related Appeals and Interferences section. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(x) are satisfied.